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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,287	01/09/2002	Denis Chalon	B-4457 619451-4	6861

7590 03/02/2005

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EXAMINER

WANG, LIANG CHE A

ART UNIT PAPER NUMBER

2155

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Am*

## Office Action Summary

Application No.

10/044,287

Applicant(s)

CHALON, DENIS

Examiner

Liang-che Alex Wang

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/9/2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/22/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-12 are presented for examination.

#### ***Paper Submitted***

2. It is hereby acknowledged that the following papers have been received and placed of record in the file:
  - a. **Information Disclosure Statements** as received on 4/22/2002 is considered.
  - b. **Preliminary Amendment** as received on 1/09/2002 is considered

#### ***Drawings***

3. The drawings are objected to because of the following informalities.
  - a. Figures 3a and 3b are objected by the examiner. Please label brief descriptions to the figures.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8 and 9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claims 8 and 9 recited the limitation of steps (b) through (d), however, steps (b)-(d) could not be found in the claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Geiger et al., US Patent Number 6,073,142, hereinafter Geiger.
8. Referring to claim 1, Geiger has taught a method of operating an electronic mail (email) system including the steps of: (e) enabling a sender to compose an email and initiate a send operation to one or more recipients in respect to the email (Col 5 lines 59-64, Figure 1); (f) intercepting the email sent by the sender (Col 10 lines 34-38, Figure 4A steps 404-406); (g) presenting the email to the sender in such a way that the sender can amend the email (Col 3 lines 47-52, Col 11 lines 11-25); (h) in response to a specified triggering event dependent on satisfaction of the sender criteria, transmitting the email to the one or more recipient (Col 3 lines 47-52, figures 4a-b, step 430.)
9. Referring to claim 2, Geiger has further taught wherein the triggering event includes a sender input (Col 11 lines 20-25).

10. Referring to claim 3, Geiger has further taught wherein the triggering event corresponds to a user not aborting the transmission of the email within a specified delay period, whereupon the end of the delay period, the email is automatically sent to the recipient(s) with no intervention (Figure 4b, step 449, Col 11 lines 34-37).
11. Referring to claim 4, Geiger has further taught wherein the triggering event corresponds to the sender opening the email and taking no action, then closing the email, whereupon the email is immediately sent to the recipient(s) with no further intervention (Col 11 lines 11-25).
12. Referring to claim 5, Geiger has further taught wherein the triggering event corresponds to the sender proactively confirming that the email should be sent, whereupon the email is immediately transmitted to the recipient(s) with no intervention (Col 11 lines 11-25).
13. Referring to claim 6, Geiger has further taught wherein either the sender specifies the delay period or it may be globally set (Col 9 lines 4-26).
14. Referring to claim 7, Geiger has further taught wherein the transmission step includes additional intervening steps such as spooling the email or handling the email by mail servers or any other operations as may be required by the particular email implementation or system architecture (see abstract).
15. Referring to claim 8, Geiger has further taught wherein following step (c) in claim 1, the sender amends the email and initiates a second operation in accordance with either step (b) in claim 1 whereupon the mail is again subjected to the transmission criteria, or the email is processed in accordance with step (d) in claim 1 where the email is immediately transmitted to the recipient(s) with no further intervention (Figures 4A and 4B).

16. Referring to claim 9, Geiger has further taught the step of checking whether the sender is listed as a recipient of the email and if the sender is identified as a co-recipient of the email, the email is processed in accordance with step (c) above, otherwise the email is transmitted immediately to the one or more recipients (f Figures 4A and 4B).
17. Referring to claims 10-12 claims 10-12 encompass the same scope of the invention as that of the claims 1-9. Therefore, claims 10-12 are rejected for the same reason as the claims 1-9.

### *Conclusion*

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (571)272-3992. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.
20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on (571)272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang *lcw*  
February 28, 2005

*Hosain Alam*  
HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER